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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ULRICH SANDER

Appeal 2009-004030
Application 10/536,567
Technology Center 2800

Before ROBERT E. NAPPI, ELENI MANTIS MERCADER, and
CARL W. WHITEHEAD Jr., *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This is a decision on appeal under 35 U.S.C. § 134(a) of the rejection of claims 14 through 29.

We affirm.

INVENTION

The invention is directed to an apparatus for reflecting out an observation beam of a stereoscopic microscope. See Page 1 of Appellant's Specification. Claim 14 is reproduced below:

14. An apparatus comprising:

a main microscope (1) including a main objective (2) having an optical axis (4), a pair of main stereoscopic observation beam paths (4a, 4b) passing through the main objective (2) and a zoom (6) in the main observation beam paths (4a, 4b), the zoom having an axis arranged at an angle to the optical axis (4) of the main objective (2);

an assistant's microscope (8); and

a beam splitter (7) arranged in the main observation beam paths (4a, 4b) between the main objective (2) and the zoom (6) for reflecting out a pair of assistant's stereoscopic observation beam paths (9a, 9b) to the assistant's microscope;

wherein the beam splitter (7) is continuously rotatable, together with the assistant's microscope (8), relative to main microscope (1) about the optical axis (4) of the main objective (2), whereby the beam splitter (7) and assistant's microscope (8) are optically usable in any rotational position.

REFERENCES

Tanaka	US 4,640,588	Feb. 3, 1987
Minami	US 4,763,968	Aug. 16, 1988
Kleinberg	US 5,052,789	Oct. 1, 1991
Howes	US 5,528,426	Jun. 18, 1996
Biber	US 5,898,518	Apr. 27, 1999
Nakamura	US 2001/0010592 A1	Aug. 2, 2001

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Corbisiero	US 6,421,173 B1	Jul. 16, 2002
Littman	DE 1 217 099	May 18, 1966

REJECTION AT ISSUE

The Examiner has rejected claims 14 through 29 under 35 U.S.C. § 103(a) as being unpatentable over Nakamura in view of Biber. The Examiner's rejection is on pages 4 through 7 of the Answer.²

ISSUES

Claims 14 through 22, 24 through 27, and 29.

Appellant argues on pages 4 and 5 of the Brief³ that the Examiner's rejection of claims 14 through 22, 24 through 27 and 29 under 35 U.S.C. § 103(a) is in error. Appellant's arguments are directed to the combination of the references being in error as Nakamura teaches away from the combination proposed by the Examiner.

Appellant's contentions with respect to claims 14 through 22, 24 through 27 and 29 present us with the issue: did the Examiner err in finding that the skilled artisan would have combined the teachings of Nakamura and Biber?

² Throughout this decision we refer to the Examiner's Answer dated August 1 2008.

³ Throughout this decision we refer to the Supplemental Appeal Brief dated June 3, 2008 and Reply Brief dated October 1, 2008.

Claim 23

Appellant argues on page 6 the Brief that the Examiner's rejection of claim 23 is in error as the combination of the references does not teach a rotatable beam deflection element as claimed.

Appellant's contentions with respect to claim 23 present us with the issue: did the Examiner err in finding that the combination of the references teaches a deflection element rotatable relative to the beam splitter as claimed?

Claim 28

Appellant argues on page 6 the Brief that the Examiner's rejection of claim 23 is in error as the combination of the references does not teach a first and second objective as claimed.

Appellant's contentions with respect to claim 28 present us with the issue: did the Examiner err in finding that the combination of the references teaches a first objective in the observation path and a second objective in the illumination beam path as claimed?

PRINCIPLE OF LAW

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Ricoh Co., Ltd. v. Quanta Computer, Inc.*, 550 F.3d 1325, 1332 (Fed. Cir. 2008) (quoting *Kahn*, 441 F.3d at 990). A reference does not teach away if it merely expresses a general preference for an alternative invention from amongst options available to the ordinarily skilled artisan, and the reference does not discredit

or discourage investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

ANALYSIS

Claims 14 through 22, 24 through 27, and 29

Appellant's arguments have not persuaded us that the Examiner erred in finding that the skilled artisan would have combined the teachings of Nakamura and Biber. Appellant argues that Nakamura teaches away from having a shared objective for the main observer and the co-observer as Nakamura teaches separate objectives to allow for independent magnification adjustment. Brief 4. Appellant relies upon paragraphs 15, 29 and 46 of Nakamura to support this allegation. The Examiner responds on page 8 of the Answer that this feature is not negated by use of a single objective.

We concur with the Examiner's finding. Initially, we note that Nakamura does not explicitly state that using a common objective for both microscopes is to be avoided. Further, the zoom feature does not preclude using one objective for both microscopes. Nakamura teaches that the assistant microscope has a zoom system, item 16. Para 28. We note from Figure 2 that this zoom system is different from the assistant's microscope's objective lenses L1, and the main microscope's zoom system 22. See Figure 1, and paras 28 and 32. Thus, we do not find that the assistant's zoom feature of Nakamura is negated (and thereby taught away from) by using the same objective for both microscopes. As such we are not persuaded that Nakamura teaches away from using one objective for both microscopes because of the disclosed separate zoom feature.

Appellant additionally argues that another advantage of Nakamura that runs counter to modifying the location of the beam splitter is the teaching that the assistant's microscope is easily removable to give a wide view. Brief 5. Appellant asserts that moving the beam splitter would make removing the assistant's microscope more challenging and the gain of space at the bottom of the microscope would not be as great. Appellant asserts that a purpose of Nakamura's device is that the observer would gain a wide view with the naked eye by removing the assistant's microscope. Thus, Appellant asserts that the combination is contrary to Nakamura and would change the principal operation and render the reference inoperative. Brief 5. The Examiner responds by stating that the proposed combination does not require the arrangement proposed by Appellant. Answer 9. Further, the Examiner cites to additional references stating that the skilled artisan would recognize that the attachment of the assistant microscope is only an optional alternative to other prior art teaching of attachment of the assistant microscope. Answer 9. While we have not considered the additional references cited by the Examiner as they were not listed in the statement of the rejection we nonetheless concur with the Examiner's finding of obviousness.

The Examiner, found that the skilled artisan would have modified the microscope of Nakamura, to use one objective as taught by Biber as it will reduce the number of parts. Answer 4-5. We consider this to be a reasonable rationale to modify the teaching of Nakamura. The Appellant's arguments have not shown that this rationale is contrary to the teachings of Nakamura. Further, while Appellant asserts that removal would be challenging Appellant has not shown that it is not possible. Thus, Appellant has not

shown that Nakamura teaches away from the combination, that the combination changes the principal operation or would render the Nakamura inoperative. Accordingly, Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 14 through 22, 24 through 27, and 29.

Claim 23

Appellant's arguments have not persuaded us that Examiner erred in finding that the combination of the references teaches a deflection element rotatable relative to the beam splitter as claimed. Claim 23 recites that the deflection element is rotatable relative to the beam splitter. The Examiner relies upon Nakamura's Figure 5 and description in paragraph 43.

Appellant argues that the light flux K4 in Figure 5 does not pass through a beam splitter. We disagree with Appellant's assertion. Figure 5 is described as an alternate embodiment to assistant's microscope. Nakamura para. 0041. In this second embodiment, light flux (K4) from the target (subject being viewed) is received by mirror M3, and not beam branching unit B1 of Figure 2. Nakamura para. 0042. While this appears to support Appellant's arguments, Nakamura describes a further alternative to this embodiment in which branching unit (beam splitter), may be used to receive light flux K4, i.e. the branching unit is used instead of mirror M3. Nakamura para. 0043. Thus, Appellant's argument that Nakamura in Figure 5 does not teach that the light passes through a branching circuit is not persuasive. Accordingly, Appellant has not persuaded us of error in the Examiner's rejection of claim 23.

Claim 28

Appellant's arguments have not persuaded us that the Examiner erred in finding that the combination of the references teaches a first objective in the observation path and a second objective in the illumination beam path as claimed. Claim 28 recites that the "first part of the main objective (2) is used for the main observation beam paths (4a, b) of the main microscope (1), and a second part of the main objective (2) is used for the illumination beam path (12a), the second part being spaced from the first path and arranged at an angle to the optical axis (4)." It is clear from the Examiner's rejection, that although Appellant has identified items 2 of Appellant's Figure 1, as the main and second objective, the Examiner has interpreted item 2 as the main objective and mirror 13 as the second objective. Assumedly, the mirror item 13 is the only element disclosed as being in the illumination beam path, spaced apart and at an angle to the optical axis (See Examiner's comment on page 10 about this being the only interpretation of claim 28 that is supported by 35 USC 112 1st paragraph).

We concur with this interpretation by the Examiner as it is consistent with Appellant's Specification. Further, Appellant's mere statement that they "disagree with the characterization of mirror M1 as being an objective" (Brief 6) is not persuasive as it neither cites to an alternative interpretation of the term "objective" nor shows that the Examiner's interpretation is inconsistent with the Specification. Thus, Appellant's arguments, directed to the combination not teaching the first and second objective parts, is not persuasive. Appellant's further argument directed to one skilled in the art of not combining the references to move the beam splitter and use a common shared objective, is not persuasive for the reasons discussed above with

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respect to claim 14. Accordingly, Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 28.

CONCLUSION

Appellant has not persuaded us of error in the Examiner's decision rejecting claims 14 through 29.

ORDER

The decision of the Examiner to reject claims 14 through 29 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED

ELD

HODGSON RUSS LLP
THE GUARANTY BUILDING
140 PEARL STREET
SUITE 100
BUFFALO, NY 14202-4040